

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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Application No.: 09/834,451 Art Unit: 3626
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Title: **TESTING METHOD AND SYSTEM**

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PRE-APPEAL BRIEF

Dear Sir:

Pre-Appeal is respectfully requested. Applicant files this Pre-Appeal Brief along with a Notice of Appeal. Pre-appeal review is the proper recourse when a rejection is based either on a clear error in law or when the Examiner fails to set forth a *prima facie* case against patentability, omitting one or more elements or limitations required in a claim. See *OG Notice*, July 12, 2005, New Pre-Appeal Brief Conference Pilot Program. In this case, the Examiner argues as part of the *prima facie* that an automated answering call system with a customer service representative can, in this art, be analogized with providing a caller with a live counselor.

As a reminder, claims 1–20 and 22–83 have been cancelled. Claims 21 and 84–105 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Welner et al. (U.S. Patent No. 5,509,064) in view of Hollatz et al. (U.S. Patent No. 6,222,919). Only claim 21 is independent. Applicant has made several arguments during prosecution directed to the independent and dependant claims; these substantive arguments are best reserved for the regular appeal process. Applicant requests pre-appeal review on the Examiner's arbitrary and unreasonable interpretation of the term "querying said user" as construed in Applicant's claims.

Applicant's method was created to meet needs resulting from the 1990s AIDS epidemic. Employees of many companies, as part of their medical insurance coverage, needed to be tested anonymously; the social stigmas associated with AIDS were often enough to lead to termination of employment. An insured employee, if given positive test results over the phone, could become a serious danger to themselves or others and give rise to liability on the part of the employer. Information, while easy to provide, is sometimes not needed or desired. Nothing can replace a live doctor consultation when such news is given.

Applicant's claim 21 provides in part:

21. In a ... method comprising the steps of:
 - receiving an inquiry initiated by one of said users;
 - prompting said user to transmit said personal identification code;
 - receiving said personal identification code;
 - in any order querying said user as to whether said user desires counseling; and
 - determining whether said personal identification code input by said user corresponds to a code lot for the employees of the specific company; ...

A user must be asked if he/she desired counseling as part of the method. This step is listed as step 1106 at FIG. 11 of the specification and on pp. 13–14. If the user desire counseling, then step 1110 is then performed as described in claim 21. If the user does not desire counseling, then step 1107 is performed. The Welner et al. reference describes a system having an automated call handler and routing system 110. (Col. 4, ll. 40–41). Welner et al. reads as follows:

As explained more fully below, call handler and routing system 110 initially provides a series of automated messages to client-callers 120 who have tested HIV negative, repeat client-callers 120 who have already been informed (during a previous call) of a positive test result and who were flagged during a previous call to whom test results are not available. Client-callers 120 who have tested positive or screen positive for the HIV virus, or whose test results were inconclusive, are transferred by call routing and handling system 110 to a counselor 140. Client-callers placing calls to call handler and routing system 110 in order to obtain general information about the at-home test kit or for other reasons are transferred by call handler and routing system 110 to a CSR for handling.” Col. 4, ll. 51–65 (emphasis added).

The Welner et al. reference teaches a fully automated system where calls are routed automatically to call handlers or counselors based on pre-existing conditions. The Welner et al. reference does not teach asking the user whether he/she desires to speak to a counselor. In the Welner et al. method, if the user has tested positive or test results are inconclusive, he/she will be transferred to a counselor. If a user does not test positive, he/she will not be transferred to the counselor. There is no query. A “query” is defined in the *Webster Online Dictionary* as “to ask questions of especially with a desire for authoritative information.”¹

When Applicant noted that Welner et al. never queries the user and automatically routes the call to either the information or to a counselor, the Examiner explained, “... the claimed in any order querying said user as to whether said user desires counseling is met by client-callers placing calls to call handler and routing system (110, Fig. 1) in order to obtain general information or for other reasons are transferred to a customer service representative (CRS) (see col. 4, ll. 61–65). The Examiner considers a caller trying to receive general information and then being transferred to a CRS equivalent to a user having a desire to be counseled.” See Final Office Action dated October 20, 2008, p. 3.

This logic is flawed. First, in Applicant’s system, a person calls and before results are obtained, the person is asked if counseling will be needed. In the Welner et al. reference, the system detects the results and automatically dispatches the caller to the customer service representative or counselor. Under Welner et al., if the results are favorable, whatever the user’s level of anxiety may be, the user does not have the option to talk to a counselor. The Examiner argues that calling back to ask for general information is somehow analogous to being queried as to a desire to speak to a counselor.

By way of illustration, below are two phone conversations embodying the two methods (automated voice in normal type, real life person in italics). Applicant’s method:

--please enter your four digit identification code--

¹ <http://www.merriam-webster.com/dictionary/querying>

--thank you. Now please type 1 if you desire to speak to a live counselor once you have been given your test results.--

--thank you. You have selected ... not to talk to a counselor ... let me look up the results for you--

The method follows the steps shown in Figs. 10 and 11. The Welner et al. reference describes a completely different method:

--please enter your four digit identification code--

--thank you.--

--*Mr. X, I am a Counselor here at*

or

--Your results are negative. You do not have HIV. If you want general information on your results, please press 1.--

The Examiner argues that the methods are the same. In the last portion of the October 20, 2008, Office Action, the Examiner explains further, "The Examiner considers client-callers (120, Fig. 1) placing calls for information such as inconclusive test results or how to use the test kit (counselor specific information) and being transferred to a counselor or customer service representative (CRS)(both are counselors) is the same as a counselor receiving counselor specific information about a user." The Examiner confuses several steps of the method. The resulting method differs greatly. Using Applicant's method, if a user refuses counseling, he/she will not receive counseling. This is not the case in the cited method. Clearly, the method differ because different results are obtained.

During patent examination, pending claims must be given their broadest reasonable interpretation consistent with the specification. *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005). Words of a claim must be given their plain meaning unless this meaning is inconsistent with the specification. *In re Zletz*, 893 F.2d 319 (Fed. Cir. 1989). Here, a caller is queried to

determine whether he/she desires to speak to a counselor. A different method where a user must call back and ask for general information about the product to talk to a counselor is unrelated.

In today's telephone customer service systems, calls can easily become nightmarish when an automated system is employed. If a person is asked to "please press 1 if you wish to talk to a live operator once the information is retrieved" while a second method only routes a call directly to a machine and the user must then offer the pretext of wanting general information about a kit to get to a live counselor, the methods differ greatly.

The Examiner's position that querying the user before data is given somehow equates to a system where calls are automatically routed and if the user calls back, then he/she will be routed on false pretext to a counselor is contrary to common sense and patent law. Accordingly, Applicant requests reconsideration and withdrawal of the rejection and issuance of a Notice of Allowance for all pending claims.

Respectfully submitted,

By

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